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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,245	07/31/2000	MANFRED GERBER	ATM-2174	9769

7590 10/21/2004

VIRGIL H MARSH
FISHER CHRISTEN & SABOL
1725 K STREET NW
SUITE 1401
WASHINGTON, DC 20036

EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/601,245

Applicant(s)

GERBER ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 102 rejections of claims 15, 16, and 22 as anticipated by Yamaguchi of record in the Office Action mailed May 18, 2004, Pages 3-4 Paragraph 6, have been withdrawn due to applicant's arguments in the Paper filed August 13, 2004.
2. The 35 U.S.C. 103 rejections of claims 17-21 over Yamaguchi of record in the Office Action mailed May 18, 2004, Pages 5-6 Paragraph 7, have been withdrawn due to Applicant's arguments in the Paper filed August 13, 2004.

REPEATED REJECTIONS

3. The 35 U.S.C. 103 rejections of claims 15-22 over Touhsaent in view of Kay are repeated for the reasons previously of record in the Office Action mailed May 18, 2004, Pages 6-8 Paragraph 8.

ANSWERS TO APPLICANT'S ARGUMENTS

4. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 15, 16, and 22 as anticipated by Yamaguchi have been considered but are moot since the rejections have been withdrawn.

5. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 17-21 over Yamaguchi have been considered but are moot since the rejections have been withdrawn.

6. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 15-22 over Touhsaent in view of Kay have been fully considered but are not found persuasive.

In response to Applicant's argument that Touhsaent requires a printed ink pattern if a lacquer coating is present, first, limitations of claim 15 do not require a lacquer layer between the functional layer and metal foil and since the printed ink pattern and lacquer layers are optional layers placed between the metal foil and functional layer Touhsaent reads on the limitations of (A) of claim 15. With regards to claims 17-21, which includes the limitation of a lacquer coating or melt extrudate in the functional layer, claim 15 is not completely closed as written. Although claim 15 has the transition clause "consisting of" which requires the claim to be fully closed, the other limitations within the consisting of clause keep the claim open. In particular (A) is "at least one functional layer of plastic with the functional layer thereof that forms outer surface of the multi-layered material being a non-adhesive

functional layer". Therefore (A) in its broadest interpretation is defined as a layer having at least one functional layer of plastic, which means that the layer can be multi-layered and consist of layers other than the one functional layer of plastic. In the case of Touhsaent, the (A) layer consists of a non-adhesive functional layer of plastic as the outer surface of (A) and a printed ink pattern and overlacquer as inner layers of (A). Note although the claims are limited to only having A-E and optionally F and G, A and C are claimed in open language.

In response to Applicant's argument that the claimed invention excludes a surface treated polymer skin layer between the metal layer and the melt extract, the Examiner agrees that Touhsaent requires the skin layer, however the claims do not exclude the skin layer. Although claim 15 is written with consisting of language, it is not fully closed. The layer (C) of claim 15 is a multi-layered plastic layer, which in its broadest interpretation is defined as a multi-layered laminate having plastic in the layers. In the claims layer (C) goes on to be defined as being "made from" a layer of a lacquer coating or melt extrudate and a non-adhesive film containing a polyolefin. "Made from" is considered open language, so therefore, although the claims are limited to only A-E and optionally F and G, C is open to multiple layers. Touhsaent

teaches a multi-layered plastic, which relates to C, made from polymer skin layer, melt extrudate, and a polymer core layer and because C is defined in the claims in open language the multilayered plastic of Touhsaent reads on the multi-layered plastic of the instant invention.

In response to Applicant's arguments that if a printed ink pattern is placed in Touhsaent to fit the optional limitations presented in the claims an overlacquer coating would also be added. First, Touhsaent does not require an overlacquer coating on the printed ink pattern. Column 7, lines 1-10 of Touhsaent teach that an overlacquer layer "may" be applied to the printed pattern to prevent the pattern from damage. Second, the multi-layered plastic layer (C) includes other layers besides D, E, and optionally G because the layer (C) is described in open language. Therefore, the overlacquer layer of Touhsaent over the printed ink pattern disposed on the surface of layer (E) would be included in the open language of multi-layered plastic layer (C).

In response to Applicant's argument that the treated surface of the skin layer is in contact with the metal layer and comprises a separate layer. Although claim 15 does have "consisting of" language, the multi-layered plastic layer (C) is defined in open language, which therefore would include the skin

layer and the surface treated skin layer within the multi-layered plastic layer.

In response to Applicant's argument that Kay cannot be combined with Touhsaent to meet the limitations of the instant claims, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. See MPEP 2145 III. In this case, the combined teaches of the references suggest to those of ordinary skill in the art that the invention of Touhsaent would be modified by embossing the metal layer in order to provide the overall laminate of Touhsaent tamperproof, as taught by Kay.

In response to Applicant's argument that it would not have been obvious to one having ordinary skill in the art to arrive at the thickness of the layers claimed. Touhsaent teaches that the sealable coating is provided in a thickness that is sufficient to impart the desired sealability, coefficient of friction, and hot slip characteristics to the laminate (col.6, 1.60-63). Therefore, one of ordinary skill in the art would have recognized that as suggested by Touhsaent routine experimentation would be required to determine the optimum

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thickness of the coating for the intended use of the laminate. Touhsaent further teaches that the multi-layered plastic layer has a thickness in the range of 12.7 to 76 micrometers, in which the core layer or non-adhesive film containing a polyolefin comprises 80-99% of the thickness. Therefore, it would have been obvious to one having ordinary skill in the art that film containing at least one polyolefin would have a thickness between 10 micrometers and 75 micrometers and the melt extrudate would be much less because it is merely the interface between the core layer and skin layer and would be determined based on the thickness of the skin and core layers (col.4, 1.14-25). One of ordinary skill in the art would have recognized that the lacquer coating found in the functional layer would be much thinner than the sealable coating and would be determined to be only thick enough to prevent damage of the ink pattern. As seen in the Figure the core layer makes up the majority of the film and therefore, all of the other layers would be thinner than the polymer core layer. Therefore, one of ordinary skill in the art would have recognized that all of the other layers would have a thickness less than 75 micrometers, including the metal deposit layer, which would be determined by scaling the thickness to relate to the polymer core layer's thickness.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the


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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB 
October 7, 2004


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/14/04